

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
Page 4

REMARKS

Claims 65 and 67-71 are pending in the subject application. Applicant has canceled claims 69-71 without prejudice. Applicant has also amended claim 65 to more particularly point out what applicant regards as the invention. Support for the amendment to claim 65 can be found, *inter alia*, in the specification at page 40, lines 28 and 29 and Figure 1D. Applicant maintains that this Amendment raises no issue of new matter. Accordingly, claims 65, 67 and 68 will be pending and under examination in the subject application upon entry of this Amendment.

In view of the arguments set forth below, applicant maintains that the Examiner's rejections made in the April 1, 2005 Final Office Action have been overcome, and respectfully requests that the Examiner reconsider and withdraw same.

The Claimed Invention

Briefly, claims 65, 67 and 68 provide a purified antibody capable of specifically binding to a human PAK4 serine/threonine kinase comprising the GTPase-binding domain contained within residues 10-30 of the amino acid sequence set forth in SEQ ID NO:2.

November 30, 2005 Examiner's Interview

Applicant wishes to thank Examiner Michael Szperka for his time and consideration during the November 30, 2005 telephonic interview with Alan J. Morrison, applicant's undersigned

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
Page 5

attorney. During the interview, the Examiner and Mr. Morrison discussed amendments to the claims which, if made, might further the prosecution of this application. Applicant directs the Examiner to the amendments and remarks made herein, which applicant maintains address the issues discussed during the interview.

Rejections under 35 U.S.C. §112, First Paragraph

In the Final Office Action, and as maintained in the Advisory Action, the Examiner rejected claims 65 and 67-71 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner stated that the instant claims are drawn to antibodies that bind all allelic variants, analogs, fragments, or derivatives of human or mouse PAK4, but that the specification fails to disclose the structure and properties of the entire genus of PAK4 analogs, fragments and derivatives.

In response to the Examiner's rejection of claims 69-71, applicant notes that these claims have been canceled herein. Accordingly, the Examiner's rejection of claims 69-71 is moot.

In response to the rejection of claims 65, 67 and 68, applicant respectfully traverses. Applicant notes that claim 65, as amended, provides a purified antibody capable of specifically binding to a human PAK4 serine/threonine kinase

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
Page 6

comprising the GTPase-binding domain contained within residues 10-30 of the amino acid sequence set forth in SEQ ID NO:2. It is noted that one skilled in the art would understand the claimed antibody to bind to the particular kinase recited in claim 65, but *not* to a human PAK4 serine/threonine kinase which lacks the recited GTPase-binding domain. Accordingly, applicant maintains that claims 65, 67 and 68 are not drawn to antibodies that bind all allelic variants, analogs, fragments, or derivatives of human or mouse PAK4, and that the claimed antibody is sufficiently described in the specification.

In view of the above remarks, applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

Rejections under 35 U.S.C. §102(e)

The Examiner rejected claims 65 and 67-71 under 35 U.S.C. §102(e), as allegedly anticipated by Plowman et al., U.S. Patent Application Publication No. US 2003/0050230 ("Plowman"). Specifically, the Examiner stated that the 398 amino acid partial PAK5 sequence (SEQ ID NO:30) disclosed in Plowman is completely contained within, and is 100% identical to, the human PAK4 sequence set forth in SEQ ID NO:2 of the instant application and, therefore, antibodies capable of binding to the 398 amino acid PAK5 sequence would anticipate the antibodies of the instant invention.

In response to the Examiner's rejection of claims 69-71, applicant again notes that these claims have been canceled herein. Accordingly, the Examiner's rejection of these claims

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
Page 7

is moot.

In response to the Examiner's rejection of claims 65, 67 and 68, applicant respectfully traverses.

Again, claim 65 provides a purified antibody capable of specifically binding to a human PAK4 serine/threonine kinase comprising the GTPase-binding domain contained within residues 10-30 of the amino acid sequence set forth in SEQ ID NO:2.

Under 35 U.S.C. §102, and as stated in M.P.E.P. §2131.01, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added). Hence, to anticipate the antibody of claims 65, 67 and 68, Plowman would have to teach each and every element thereof.

Plowman fails to do this.

Plowman teaches a polypeptide (i.e., the polypeptide of SEQ. ID. NO:30) which corresponds to residues 194-591 of applicant's PAK4 whose sequence is shown in SEQ. ID. NO:2. Applicant stresses that the polypeptide of Plowman does *not* contain the GTPase-binding domain of applicant's PAK4, which domain is located at the N-terminus (i.e., residues 10-30) of SEQ. ID. NO:2. Consequently, the antibody of Plowman cannot anticipate the instant antibody which is capable of specifically binding to a human PAK4 comprising the *GTPase-binding domain contained within residues 10-30 of the amino acid sequence set forth in SEQ ID NO:2*. Therefore, Plowman

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
Page 8

fails to teach each and every element of the claimed invention.

In view of the above remarks, applicant maintains that claims 65, 67 and 68 satisfy the requirements of 35 U.S.C. §102(e).

Summary

Applicant maintains that the claims pending are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicant: Audrey Minden
Serial No.: 10/693,367
Filed: October 24, 2003
Page 9

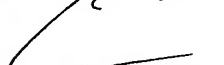
No fee, other than the enclosed sum of \$1240.00 (including the \$450.00 extension fee and the \$790.00 RCE fee), is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450


Alan J. Morrison
Reg. No. 37,399

2/6/06
Date